

REMARKS/ARGUMENTS

The Applicants respectfully request that the Examiner consider the following remarks in addition to the amendments presented above in view of the 3 December 2004 final Office action and the 31 March 2005 in-person interview.

Interview Record Under MPEP § 713.04

On 31 March 2005, the undersigned attorney interviewed this case in person with Examiner Rosiland Rollins. Pursuant to MPEP § 713.04, the Applicants record the substance of the interview as follows:

- (A) Brief description of the nature of any exhibits shown or any demonstrations conducted:
No exhibits of the claimed invention were shown and no demonstrations were conducted.
- (B) Identification of the claims discussed: Independent claims 1, 11, and 17, and proposed amendments to these claims, were discussed.
- (C) Identification of specific prior art discussed: U.S. Patent No. 6,080,151 to Swartz et al. was discussed.
- (D) Identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary form completed by the examiner: (see Interview Summary form prepared by Examiner Rollins)
- (E) The general thrust of the principal arguments of the applicant and the examiner: (see Interview Summary form prepared by Examiner Rollins)
- (F) A general indication of any other pertinent matters discussed: (see Interview Summary form prepared by Examiner Rollins)
- (G) General results or outcome of the interview: (see Interview Summary form prepared by Examiner Rollins)

Premature “Final” Office Action

As previously discussed with the Examiner, the Applicants respectfully submit that the 3 December 2004 Office action has been prematurely made “final.” Per the Manual of Patent

Examining Procedure, “a second … action on the merits in any application … will not be made final if it includes a rejection, on newly cited art, … of any claim not amended by applicant … in spite of the fact that other claims may have been amended to require newly cited art.” MPEP § 706.07(a), ¶ 2 (8th ed., rev. no. 2, May 2004) (emphasis added). The following claims were not amended in response to the first Office action, mailed 7 June 2004, and remain pending and not withdrawn in the application: 17, 18/17, 19/17, and 20/17. Nevertheless, in the latest Office action, these claims have been rejected on newly cited art. In particular, each of the pending claims is now being rejected based upon U.S. Patent No. 6,080,151 to Swartz et al. (hereinafter Swartz ‘151), which was previously not relied upon by the Examiner. Swartz ‘151 was cited to the Examiner on an IDS filed under 37 C.F.R. § 1.97(b)(3) on 5 March 2004 (i.e., before the 7 June 2004 mailing date of the first Office action on the merits).

The Applicants thus request that the Examiner reconsider and withdraw, under MPEP § 706.07(d), the “finality” of the 3 December 2004 Office action.

Claim Rejections – 35 USC § 102(e) and 35 USC § 103(a)

Claims 1-4, 8-16, 18/1, and 18/11 currently stand rejected under § 102(e) as being anticipated by Swartz ‘151. Claims 19/1, 19/11, 20/1, and 20/11 currently stand rejected under § 103(a) as being unpatentable over Swartz ‘151. Claims 5-7, 18/17, 19/17, and 20/17 currently stand rejected under § 103(a) as being unpatentable over Swartz ‘151 in view of U.S. Patent application publication no. 2003/0131713 to Stewart et al. (hereinafter Stewart ‘713).

The Applicants proposed amendment to independent claim 1, which was shown to and discussed with the Examiner during the interview, are formally presented above. The Applicants respectfully submit that the catheter of claim 1 is neither anticipated by nor rendered obvious in view of the cited references, whether considered alone or in combination. Dependent claims 2-9, 12, and 21-23 depend directly or indirectly from independent claim 1 and, thus, are felt to be allowable in view of the discussion with the Examiner. Each of these dependent claims also adds limitations that further distinguish the cited prior art. The Applicants have cancelled dependent claim 10, which previously depended from independent claim 1.

As discussed with the Examiner during the 31 March 2005 interview, claim 11 has been amended to include a loop structure transverse to a longitudinal axis of the catheter shaft. Thus, the Applicants respectfully submit that claim 11 is neither anticipated by nor rendered obvious in view of the cited references, whether considered alone or in combination. Claims 14-16 and 18-20 depend directly or indirectly from independent claim 11. Also, dependent claims 14-16 and 18-20 add limitations that further distinguish the cited prior art. The Applicants thus respectfully submit that each of dependent claims 14-16 and 18-20 is also now in condition for allowance.

As discussed with the Examiner during the interview, the Applicants have amended independent claim 17 to further clarify some of the differences between the claimed “shape retention means” and what is disclosed in the cited references. In particular, the Applicants claimed shape retention means functions to bias the distal or working portion of the ablation catheter toward a pre-determined shape (e.g., toward the looped structure shown in, for example, Figs. 1-3). In contrast, in Stewart ‘713, the distal wire segment 114 depicted in Fig. 7 of Stewart ‘713 helps anchor the distal end of the guide catheter 110. Thus, the distal wire segment 114 depicted in Fig. 7 of Stewart ‘713 secures an outer, guide catheter 110 so that a treatment catheter, like the Applicants’ claimed catheter, may be slid within the guide catheter 110 in order to place the working, inner catheter adjacent to tissue to be treated or mapped. The Applicants, therefore, respectfully submit that the claimed shape retention means, which shapes the working portion of the catheter itself into a desired configuration, is different from the guide catheter anchor 114 disclosed in Stewart ‘713. The Applicants thus submit that independent claim 17 is also in condition for allowance. Dependent claims 24-26, which depend directly or indirectly from independent claim 17 and which are based upon dependent claims 18-20, respectively, are also in condition for allowance as depending from an allowable independent claim.

Conclusion

Following entry of the above claim amendments, the following claims will be pending in this application: 1-9, 11, 12, and 14-26. The Applicants respectfully submit that each of these claims is now in condition for allowance. If the Examiner has any further questions or needs any clarification, she is encouraged to contact the undersigned attorney.

Respectfully submitted this 16th day of May 2005.



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